

**REMARKS**

Claims 1-10 and 12-19 are pending in this application. By this Amendment, claims 1-10, 12-16, 18 and 19 are amended, as is the specification. Claim 11 is canceled without prejudice to, or disclaimer of, the subject matter recited in that claim. The amendments to the claims and to the specification introduce no new matter as they serve only to better clarify issues which were raised in the Office Action. Reconsideration based on the above amendments and the following remarks is respectfully requested.

The Office Action, in paragraph 2, states that the Information Disclosure Statement filed on October 11, 2000 fails to comply with 37 C.F.R. §1.198(a)(3) because it does not include a concise explanation of the relevance of each patent listed that is not in English. Therefore, the Office Action states, the Information Disclosure Statement has been placed in the application file, but the information referred to therein has not been considered.

Applicant respectfully submits that paragraph 2 of the Information Disclosure Statement clearly states that the relevance of the non-English language references listed on the Form PTO-1449 is addressed in the specification. Applicant further respectfully submits that the disclosure clearly points out the relevance of each of the listed references (page 5, line 6 - page 6, line 9). As such, Applicant has complied completely with the requirements of 37 C.F.R. §1.98(a)(3). Applicant respectfully requests that the Examiner enter and consider the references listed in the October 11, 2000 Information Disclosure Statement, and acknowledge consideration of those references by forwarding a copy of the Form PTO-1449 which was submitted with that Information Disclosure Statement, initialed to indicate consideration of the references contained therein, to Applicant's undersigned representative.

The Office Action, in paragraph 3, objects to the specification for incorporation of essential material by reference to a foreign application or patent asserting that this is "improper." Applicant respectfully submits that there is, in fact, no incorporation by

reference of a foreign application or patent, or publication, in this disclosure. Rather, Applicant's disclosure lists a number of foreign references and, as noted above, clearly states the relevance of each of those references by describing the principles of the inventions disclosed therein and particularly the disadvantages associated with each of those inventions. It is these disclosed disadvantages which the preferred embodiments according to this invention are directed at overcoming.

The Office Action, in paragraph 4, objects to the disclosure for failing to include an Abstract. Applicant's representative has carefully reviewed the application submission in this matter and the USPTO dated filing receipt acknowledging acceptance of all pages of the specification as filed which included an Abstract. In an effort to expedite prosecution of this application, however, Applicant respectfully submits the attached copy of the original Abstract, as filed, as a substitute for the Abstract originally filed with the application.

The Office Action, in paragraph 5, objects to the disclosure because it contains an embedded hyperlink and/or other form of browser-executable code. The specification is amended to obviate the objection.

The Office Action, in paragraph 6, states that a substitute specification in proper idiomatic English is required. A number of paragraphs in the specification are amended by this Amendment. These amendments to certain paragraphs of the specification are made voluntarily to improve the clarity and readability of the specification. Otherwise, however, the application is presented in English in accordance with 37 C.F.R. §1.52(b)(1)(ii) and clearly complies with all other requirements delineated in 37 C.F.R. §1.52(a) and (b), despite the assertion to the contrary in the Office Action.

In view of the foregoing, withdrawal of all objections to the specification is respectfully requested.

The Office Action, in paragraphs 7-12, apparently rejects all of claims 1-19 under 35 U.S.C. §112, second paragraph. Specifically, the Office Action states that the claims are "generally narrative and indefinite, failing to conform with current U.S. practice." Additionally, claims 1, 6, 8, 13 and 14 are specifically rejected for lacking antecedent basis in certain of the features. These rejections are respectfully traversed.

Claims 1-10, 12-16, 18 and 19 are amended to obviate the rejections under 35 U.S.C. §112, second paragraph. Accordingly, reconsideration and withdrawal of the rejections of the claims under 35 U.S.C. §112, second paragraph, are respectfully requested.

The Office Action, in paragraphs 14-16, rejects claims 15 and 19 under 35 U.S.C. §102(e) as being anticipated by U.S. Patent No. 6,449,721 to Pensak et al. (hereinafter "Pensak"). This rejection is respectfully traversed.

Pensak is directed to a method that provides for encrypting electronic information such as a document so that only users with permission may access the document in decrypted form (Abstract). In Pensak, all steps taken to create encryption policies and to encrypt data are taken by a first client (authorizing user) and no interaction is required by the second client (viewing user) (col. 6, lines 25-39). Further, there is nothing in Pensak to reasonably suggest applying a predetermined calculating operation to a challenged character string and a second secret information, thereby generating an encryption key. Specifically, the Office Action cites col. 7, lines 34-59 as teaching such a method. Applicant respectfully submits that "the server 206 generates a random encryption key for each segment ID and communicates the encryption key to the authoring user's computer 222, 1054" and the language that follows cannot reasonably be read to teach or suggest causing the first client to apply a predetermined calculating operation to the challenged character string and second secret information, thereby generating an encryption key.

Claim 15 recites, among other features, transmitting secret information from a first of a plurality of clients to a second of the plurality of clients; transmitting an encryption key from the first of the plurality of clients to the second of the plurality of clients; encrypting, by the second of the plurality of clients, the secret information by using the encryption key; and storing the encrypted secret information, by the second of the plurality of clients, in a secondary memory device. Claim 19 recites, among other features, transmitting first secret information from a first of a plurality of clients to a second of the plurality of clients; transmitting, by the second of the plurality of clients, a challenge character string to the first of the plurality of clients; applying a predetermined calculating operation to the challenge character string and the first secret information, thereby generating an encryption key by the first of the plurality of clients; transmitting the encryption key from the first of the plurality of clients to the second of the plurality of clients; and storing, by the second of the plurality of clients, protected secret information obtained by encrypting the secret information by using the encryption key in a secondary memory device.

Applicant respectfully submits that there is nothing in Pensak that teaches or suggests any of the actions undertaken by the second of the plurality of clients as separately recited in claims 15 and 19. Specifically, Pensak neither teaches nor suggests encrypting, by the second of the plurality of clients, the secret information by using the encryption key; and storing the encrypted secret information, by the second of the plurality of clients, in a secondary memory device, as is recited, among other features in independent claim 15. Further, Pensak neither teaches nor suggests transmitting, by the second of the plurality of clients, a challenge character string to the first of the plurality of clients ... and storing, by the second of the plurality of clients, protected secret information obtained by encrypting the secret information by using the encryption key in a secondary memory device. For at least these reasons,

Applicant respectfully submits that Pensak does not anticipate all of the features recited in claims 15 and 19.

Accordingly, reconsideration and withdrawal of the rejection of claims 15 and 19 under 35 U.S.C. §102(e) as being anticipated by Pensak are respectfully requested.

The Office Action, in paragraphs 18-61, rejects claims 1, 2, 4-10 and 12-14 under 35 U.S.C. §103(a) as being unpatentable over what is alleged to be Applicant's Admitted Prior Art (AAPA). This rejection is respectfully traversed.

The Office Action asserts, at page 7, item 26, that "the AAPA discloses all of the steps of the instant invention [although] they originate from a discussion of several different technologies", and that "[i]t would have been obvious... to combine all the steps into one embodiment." This assertion of obviousness is groundless, and Applicant respectfully submits that the CCPA cases in support of it are taken out of context. Under the logic implicit in this assertion, nothing would ever be patentable, because all inventions are necessarily a combination of already known elements. This logic is clearly in error, because it is well established in patent law that new combinations of old elements may be patentable. Even if all of the claimed elements are separately present in the collective prior art of record (and Applicant respectfully submits that they are not, as discussed in more detail below), the Patent Office must establish some reasonable motivation to combine these elements, beyond a bare assertion that "because the elements are all present in the prior art, collectively, it would have been obvious to combine them."

Additionally, despite the conclusions to the contrary in the Office Action, Applicant respectfully submits that the disclosure is clear in the assertion that each of the prior art references discussed under the Description of the Related Art either individually, or when taken in combination, suffer certain shortfalls. These shortfalls are enumerated at page 8, lines 19-27. Specifically, the Description of the Related Art concludes by pointing out that

the disclosed references, when taken individually, or in combination, suffer from the shortfalls in that it is difficult to safely manage and transfer capabilities in association with variations diversified in privilege contents to include, for example, an expiration date of usage, and/or a number of valid uses prior to expiration of the privilege. Additionally, even if combined, the alleged Admitted Prior Art suffers from the shortfall of it being difficult to invalidate certain capabilities without invalidating all of the capabilities related to a corresponding object. The subject matter of the enumerated claims thus provides for differentiation of privileges for different users associated with a single object. The subject matter of the enumerated claims results in an improved capability to safely manage, transfer and/or invalidate access privilege.

Furthermore, Applicant respectfully submits that the Examiner has used Applicant's specification as a road map in order to piece together marginally related technologies in finding the subject matter of the enumerated claims to have been obvious. It is well established that the use of such hindsight interpretation is improper.

Accordingly, reconsideration and withdrawal of the rejection of claims 1, 2, 4-10 and 12-14 under 35 U.S.C. §103(a) as being unpatentable over AAPA are respectfully requested.

The Office Action, in paragraphs 62-68, rejects claims 3 and 11 under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 5,263,157 to Janis in view of Pensak. This rejection is respectfully traversed.

The Office Action indicates that Janis does not disclose applying a predetermined calculating operation to information comprising at least the privilege information and the secret information to thereby generate protected privilege information capable of being safely transferred to another client. The Office Action rather relies on Pensak for this feature stating that Pensak discloses encrypting information in order to be able to transfer the information

without it being compromised, and concluding that it would have been obvious to apply calculating operation to the information.

Applicant respectfully submits that for at least the reasons enumerated above, Pensak does not disclose the features recited in the claims. Specifically, Applicant respectfully submits that Pensak's disclosure of a remote server storing a unique identifier for the information, and associating an encryption/decryption key pair and access policies with the information (Abstract) cannot reasonably be read to suggest holding user information and secret information to be shared by at least one server; generating privilege information; and applying a predetermined calculating operation to information comprising at least the privilege information and the secret information, thereby generating protected privilege information to be safely transferred to a client, as it is recited, among other features, in claim 3. The cancellation of claim 11 renders the rejection of this claim moot.

Accordingly, reconsideration and withdrawal of the rejection of claim 3 under 35 U.S.C. §103(a) as being unpatentable over Janis in view of Pensak are respectfully requested.

The Office Action, in paragraphs 69-74, rejects claims 16-18 under 35 U.S.C. §103(a) as being unpatentable over Pensak. This rejection is respectfully traversed.

The Office Action asserts that Pensak teaches all of the features of independent claims 16 and 18, except that Pensak does not teach, the Office Action states, "the first client transmitting a decryption key for decrypting the information encrypted by the encryption key to the second client; and the second client decrypting the protected secret information by using the decryption key, thereby obtaining secret information." The Office Action concludes that it would have been obvious to have the first client transmit the decryption key to the second client.

Applicant respectfully submits that were it obvious, a reference could be found to prescribe at least the actions of the first client and the second client in this regard. Further, Applicant respectfully reasserts the argument made above with respect to the application of Pensak to claims 15 and 19. Specifically, Pensak neither discloses nor suggests any affirmative action taken on the part of the at least the second of the plurality of clients, to include storing, by the at least the second of the plurality of clients, the received protected secret information in a secondary memory device ... and decrypting, by the at least the second of the plurality of clients, the protected secret information by using the decryption key, thereby obtaining secret information, as is recited, among other features, in independent claim 16. Further, with regard to independent claim 18, the at least the second of the plurality of clients additionally transmits the decryption key to the at least the first of the plurality of clients. Applicant respectfully submits that transmitting encryption and decryption keys between clients in the manner recited in claims 16 and 18, in combination with all of the other features recited in those claims, is not suggested by the disclosure of Pensak.

Accordingly, reconsideration and withdrawal of the rejection of claims 16-18 under 35 U.S.C. §103(a) as being unpatentable over Pensak are respectfully requested.

In view of the foregoing, Applicant respectfully submits that this application is in condition for allowance. Favorable reconsideration and prompt allowance of claims 1-10 and 12-19 are respectfully requested.

Should the Examiner believe that anything further would be desirable in order to place this application in even better condition for allowance, the Examiner is invited to contact Applicant's undersigned representative at the telephone number set forth below.

Respectfully submitted,



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JAO:DAT/djb

Attachment:

Substitute Abstract

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